In the

Supreme Court of the United States

OCTOBER TERM, 19

Term, April, A. D. 1899

WILLIAM A. BRADY,

Plaintiff in Error,

vs.

AUGUSTIN DALY,

Defendant in Error.

Brief of Plaintiff in Error.

A. J. DITTENHOEFER,

Of Counsel.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1898.

WILLIAM A. BRADY, Plaintiff in Error, *against* AUGUSTIN DALY.	No. 273.

This case comes before this Court on a writ of error to the Circuit Court of Appeals for the Second Circuit, allowed by Mr. Justice Brewer (pp. 185–186).

The action was brought under Section 4966 of the Revised Statutes to recover penalties for certain performances alleged to have been given by Brady, the plaintiff in error (defendant below) of the play "After Dark." In said play there is a scene of a locomotive and cars crossing the stage while one of the characters is on the track in danger of his life from the passing train; and the contention of the defendant in error (plaintiff below) is that a single incident in that scene, to wit: the *manner of the rescue of the endangered character* violated the copyright of his play "Under the Gaslight, a Romantic Panorama of the Streets and Homes of New York."

On the 20th day of May, 1889, defendant in error commenced a suit in equity against George P. Webster, the plaintiff in error William A. Brady and Henry C. Miner claiming that the *entire railroad scene* in "After Dark" (37) was taken from said copyrighted play, "Under the Gaslight."

A motion for an injunction *pendente lite* was, on *June 20, 1889*, denied by Judge Wallace, who held complainant's copyright invalid (see Order Defendant's Exhibits B, 50–51 ; Findings 19).

On final hearing on *November 4, 1891*, the Circuit Court, Judge Coxe presiding, following the decision of Judge Wallace, dismissed the bill of complaint on the merits, with costs (see Defendant's Exhibit C, 51 ; Findings, 19).

On appeal by the complainant, defendant in error, the Circuit Court of Appeals reversed the said decree on the *4th of October, 1892* (Findings, 19).

The play performed by the defendants in said suit was *concededly dissimilar in every particular from complainant's play* "Under the Gaslight," excepting as to the railroad scene.

The Circuit Court of Appeals held, in the equity suit, that the incidents of a train of cars passing in view of the audience and of a character in imminent danger of his life from the train, were old and did not belong to the complainant. The only incident sustained as new and original with him was the *manner in which the one character was rescued by the other.* The following is the language used by the Court:—

"On another occasion, however, defendant's "play was so modified that the imperilled person "was placed upon the tracks, so stupefied with "some drug as to be unable to intelligently direct "his own movements, and so environed (the scene "is laid in a narrow tunnel) that it seemed reason-

" ably certain he would be in his place of peril
" when the train arrived. So far the change of in-
" cident made no material change in the story, but
" he was saved from death, *without the aid of any*
" *third person*, at one time by staggering off the
" rails in time, at another by striking inadvert-
" ently against the operating arm of a switch,
" which moved, and thus side-tracked the train.
" This grouping of the incident, dispensing, as
" it does, entirely with the rescuer, whose efforts
" to aid and whose struggles to overcome the
" obstacles in his (or her) way are an
" important part of the complainant's com-
" position, tell a substantially different story.
" *Moreover, in all except the rescue by a third*
" *person the complainant was not the first to con-*
" *ceive the story.* Of course, in mere peril and
" rescue—peril which the imperilled person is
" helpless to avert, rescue at the last moment by
" exertion against obstacles—there was nothing
" which any one in this age of the world could
" claim as his own. What complainant contends
" to be his own conception was the introducing of
" the moving railroad train as the source of peril,
" and confinement to its track as a method of
" assassination. But before he copyrighted his
" play, there had been published in a monthly
" magazine (the 'Galaxy') a story entitled 'Cap-
" tain Tom's Fright.' It differs entirely from
" plaintiff's play, except that it contains a 'rail-
" road scene,' in which a person is tied upon a
" railroad track, so as to be in apparent peril of his
" life from any approaching train. From this peril
" he is rescued by the circumstance unexplained
" and unexpected, that a switch had been turned
" so that the train, which did come past him,
" not on the straight track, but on a cut-off. *Such*
" *incidents of peril from railroad trains and*
" *rescue therefrom being common literary prop-*

"*erty* (it does not appear that 'Captain Tom's "Fright' was copyrighted), *it is apparent that* "*the complainant's composition is novel only by* "*reason of the introduction of the rescuer, whose* "*presence is therefore so essential to the 'dra-* "*matic composition' that a representation which* "*dispenses with his presence would not be an in-* "*fringement.*" (Italics ours.)

On that extremely narrow ground it was held that the pantomimic incident of the rescue by a third person in the railroad scene constituted the sole infringement.

The case was remanded with instructions to enter the usual decree for an accounting and a perpetual injunction (see Mandate, 52–19).

Accordingly, on the 5th day of November, 1892, a decree was entered, awarding an injunction and referring it to a master, to ascertain and report an account of the number of times the said railroad scene was used by the defendants, without the sanction of the complainant, in said dramatic composition "After Dark" and where each of said unauthorized performance took place and the terms and agreements under which said performances took place; and Daly was accorded the right to examine the defendants, their books, vouchers and documents, and they were directed to attend for such purpose before the Master, from time to time as he shall direct (53–54).

An accounting was thereupon had before the Master. *The only witness examined by the complainant was the defendant Brady*, who was subpœnaed to produce his books and papers (19). When Brady was compelled to produce the manuscript of his play, the objection made by his counsel that he could not be compelled to testify or produce his books for the reason that it would tend to render him liable to the statutory penalty, was overruled (see Findings, 19).

From the evidence thus *forced* from the defendant, it appeared that intermediate the decisions of Judges Wallace and Coxe in his favor and the reversal of those decisions by the Court of Appeals, certain performances of "After Dark" were given with the incident of the rescue in the manner held to belong to Daly; *none, however, prior to the decision of Judge Wallace and none after the reversal by the Court af Appeals* (55). Based upon that report, a final decree was entered April 1st, 1893 (Plaintiff's Exhibit 2D 61). An appeal therefrom was dismissed by this Court on technical grounds (Daly *vs.* Webster, 163 U. S., 155). This action was commenced August 23d, 1893 (see finding 24), under Section 4966 of the Revised Statutes to recover $100 for the first performance and fifty dollars for every subsequent performance given by the defendant (3–7).

The case came on for trial at the Circuit Court before Judge Shipman. The plaintiff (Daly) contended that the action *was not to recover penalties* but for damages, and tried his case on that theory. He rested his case on the introduction of the record in the equity suit (34–62), and the deposition of Mr. Daly showing royalties received by him from others who had produced his play (166). The defendant Brady sought to show the invalidity of plaintiff's copyright and that the incident of the manner of the rescue was not original with Daly, but all defenses were excluded upon the ground that the decree in equity was *res adjudicata* (63–70–77). Brady also sought to show that the incident of the rescue of an imperilled character by another in his play has no pecuniary value, and that whether the rescue be accomplished by the individual in danger of his life staggering from the track—which was held by this Court to be no infringement—or by being

removed from the track by another person, made no material difference. That evidence was also excluded (62), to which exception was duly taken and error assigned (171). Judge Shipman, took the case under advisement and subsequently rendered a decision that as the action was penal in its nature Brady's evidence in the equity suit was inadmissible and dismissed the complaint, with costs (16–21). Thereupon plaintiff moved for a new trial mainly on the affidavit of his counsel, setting forth that he had misconceived the nature of the action; that he "believed that this action was an action for damages and could be sustained without reference to the clause in the statute, which was alleged to be penal in its character," and that "the decision of the Court has taken him by surprise" (85). It was not pretended that he had *in Court, at the trial, any witness whom he did not call*, and the fact is undisputed that there was not a single witness present to testify as to the performances alleged to have been given (91).

Solely on said statement of counsel that he was mistaken as to the nature of his action and as to the proof required to sustain it, the learned Judge granted a new trial, saying that "the questions of statutory law involved in this case are important to both the parties, and the final decision by an Appellate Court upon all the accessible facts will be valuable to those interested in the law of copyright relating to dramatic compositions" (92).

On said first trial, as we have shown, counsel tried his case as an action for damages—not to recover penalties—and the Court admitted in evidence the decree in equity to prove plaintiff's cause of action, *and excluded all evidence offered by defendant on the ground that the decree was res adjudicata;* but in granting the plaintiff an op-

portunity to try his case over again upon a different theory, the learned trial Judge, instead of awarding a new trial upon *all the issues* and giving the defendant an opportunity to introduce proofs, admissible in a penal action, ordered that only "testimony in regard to the number and times of the representations, if any, there were, of the play 'After Dark,' by the defendant within two years prior to the commencement of this suit," should be admitted (92-93). The new trial was granted November 15th, 1895 (92), and was had April 9th, 1896 (93). During those five months, the plaintiff having before him the testimony of the defendant, in the equity suit forced from him before the Master showing the times and places of performances (55-61), issued commissions to take the testimony of certain members of the company performing in the play (100–131), and certain managers of the theatres where Brady's evidence in the equity suit showed the play had been produced (110–117). No proof of the other allegations of the complaint was introduced, and upon all the other issues plaintiff rested on the record in the equity suit. That record included the *verified* answer of the defendant (see Answer, Plaintiff's Exhibit 1 B, 43, and order of April 15th, 1897, amending the bill of exceptions, to show that the original answer was duly verified, 166). The answer was necessarily verified because complainant refused to waive the defendants oath (see Bill of Complaint, 37). After the second trial, Judge Shipman withdrew his decision, dismissing the complaint, and awarded judgment against the defendant for penalties amounting to $6,300, being at the rate of one hundred dollars for the first performance, and fifty dollars for each subsequent performance; the learned Judge finding that the defendant had given one hundred and twenty-six performances of "After Dark" with the rescue

conducted in the manner that violated plaintiff's copyright (24).

The plaintiff in error assigns the following as error :

1st. That the Circuit Court has no jurisdiction of an action to recover penalties, such jurisdiction being vested in the District Court.

2d. That under Section 4966, a penalty is incurred only when the entire play, or substantially the entire play, is produced—not when merely an incident in one of the scenes is reproduced.

3d. That it was error to admit in evidence in this *quasi* criminal action, the defendant's sworn answer filed by him in the equity suit, to which the oath of the defendant had not been waived.

4th. That it was error to admit in evidence the record in the equity suit as sufficient to prove the material allegations of the complaint in this penal action.

5th. That it was error to hold that the decree in the equity suit was *res adjudicata*, precluding defendant from introducing evidence that the railroad scene and the manner of the rescue were public property and not original with the plaintiff.

6th. The Court erred in holding that though the performances complained of were given intermediate the decisions of Judges Wallace and Coxe, holding the copyright invalid, and the reversal by the Court of Appeals they were wilful in a criminal sense, and that defendant was liable for the penalties provided by § 4966 of the Revised Statutes.

7th. The Court erred in holding that the plaintiff, by proceeding in equity for an accounting of profits, did not make an election precluding a recovery for penalties.

8th. The Court below, in granting a new trial, committed error in limiting the defendant in his defenses upon such new trial.

9th. The trial Judge erred in permitting the plaintiff upon the new trial, to prove the times and number of performances of "After Dark" after the defendant had been compelled in the equity suit to make said disclosure.

POINTS.

I.

The Circuit Court has no jurisdiction of an action to recover a penalty.

The Judiciary Act of 1789 provided:

> "That the District Courts shall have * * * "exclusive original cognizance * * * of all "suits for penalties and forfeitures incurred "under the laws of the United States." (§ 9).

While the Circuit Courts were given original "cognizance of all suits of a civil nature, at law or "in equity, where the matter in dispute exceeds, "exclusive of costs, the sum or value of $500," they had no original jurisdiction in suits for penalties or forfeitures arising under the laws of the United States, which jurisdiction was vested in the District Courts.

Ketland *vs.* The Cassius, 2 Dall. 365.

By the Act of 1819, (Chapter 197) the Circuit Courts were given original cognizance, "as well in "equity as at law of all actions, suits, controversies "and cases, arising under any law of the United

"States, granting or confirming to authors or in-
"ventors the exclusive right to their respective
"writings, inventions and discoveries."

Under the general patent law of 1836, (Chapter 357) the same section was re-enacted, limited, of course, to inventors. (Section 17).

In 1842, when the act supplementary to the act of 1836 was passed (Ch. 263, Sec. 5), penalties were imposed for marking unpatented articles with the name, or any imitation of the name, of any patentee of a patented article, for the purpose of deceiving the public, and it was provided, that the party so offending shall be liable, for such offense, to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the Circuit Courts of the United States or in any of the District Courts of the United States, having the powers and jurisdiction of a Circuit Court.

The general act which gave the Circuit Courts jurisdiction as well in equity as at law, of all actions, suits, controversies and cases, arising under any law of the United States granting to authors or inventors the exclusive rights to their respective writings, inventions and discoveries, did not give the Circuit Courts jurisdiction of an action to recover a penalty under the patent law, and therefore in the act of 1842, jurisdiction was specifically vested in those Courts to recover the penalty imposed by that act.

In 1870, when the act was passed "to consolidate and amend the statutes relating to patents and copyrights," (16 St. at large, 206), the Circuit Courts were given jurisdiction of all actions, suits, controversies and cases arising under the copyright laws of the United States, "as well in law as at equity, *whether civil or penal in their nature.*"

When, however, the statutes were revised in 1874, the District Courts were given jurisdiction of all suits for penalties and forfeit-

ures incurred under any law of the United States (563, sub. 3), and Circuit Courts were vested with jurisdiction generally of all suits at law or in equity, arising under the patent or copyright laws of the United States (Section 629, Sub. 9).

It will thus be noticed that when the statutes were revised, the jurisdiction of the District Courts of suits to recover penalties or forfeiture *under any law of the United States*, was left undisturbed, and the jurisdiction of the Circuit Court in actions and suits at law or in equity arising under the patent or copyright laws of the United States, was restated in substantially the same general terms as in the act of 1819, but without giving those Courts jurisdiction of suits for penalties or forfeitures, or actions of a penal nature.

It will also be found that in revising the statutes, under the title of "Patents, Trademarks and Copyrights," Congress provided, as theretofore, that any person marking any patented article with the name of another person who has obtained a patent therefor, without the consent of such patentee, shall be liable to a penalty of not less than one hundred dollars, to be recovered, by suit *in any District Court of the United States* (Section 4901).

The Act of 1842 had vested that jurisdiction in the *Circuit Courts*.

By Section 4960 it was provided that for every failure on the part of the proprietor of any copyright to deliver to the Librarian of Congress the copies of the publication as required by the act, the proprietor of the copyright shall be liable to a penalty of $25, to be recovered by the Librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, *in any District Court* of the United States within the jurisdiction of which the delinquent may reside or be found.

Section 4963 imposes a penalty for impressing

notice of copyright upon an article for which no copyright has been obtained, *without vesting the Circuit Courts with jurisdiction to recover said penalty.*

Section 4964 provides that where a person, after recording the title of a book, shall, without the consent of the proprietor of the copyright, print, publish or sell any copy of such book, he shall forfeit every copy thereof to such proprietor, and shall "also forfeit and pay such damages as may be "recovered in a civil action by such proprietor *in* "*any Court of competent jurisdiction.*"

Section 4965 provides for forfeitures for violating the rights of the proprietor of a copyright of maps, charts, prints &c., *without vesting jurisdiction in the Circuit Court*, over such actions.

Section 4966 is the one under consideration.

Section 4970 provides that the "Circuit Courts "and District Courts having the jurisdiction of "Circuit Courts shall have power, upon *bill in* "*equity*, filed by any party aggrieved to grant in- "junctions to prevent the violation of any right "secured by the laws respecting the copyrights, "according to the course and principles of Courts "of equity, on such terms as the Court may deem "reasonable."

It will thus be seen that there is no provision in the revised statutes, *expressly* vesting in the Circuit Courts jurisdiction over an action to recover a penalty, unless the general words giving the Circuit Courts jurisdiction of actions under patent and copyright laws, annul the provision giving exclusive jurisdiction to the District Courts "of *all* suits to recover penalties and forfeitures under *any* law of the United States." In fact, we find that while the supplementary act of 1842, vested the Circuit Courts with jurisdiction over penal actions in certain cases care was taken to provide that actions

for penalties shall only be brought in the District Courts (§ 4901).

In *United States* vs. *Mooney*, *116 U. S.*, *104*, this Court had occasion to construe the provisions *specifically* vesting the District Courts with jurisdiction of actions for penalties and the provisions giving the Circuit Courts *general* jurisdiction of certain classes of actions. The Court said :

> " The ninth section of the Judiciary Act of " September 24, 1789, Ch. 20, 1 Stat. 76, pro- " vided as follows: 'The District Courts shall " have exclusive original cognizance' 'of all " suits for penalties and forfeitures incurred " under the laws of the United States.' Since " the passage of that act several statutes have " been enacted giving the Circuit Courts juris- " diction of suits for penalties and forfeitures " (Rev. Stat , Sec. 629, subdivisions 4, 5, 7, 15), " but it is conceded by the counsel for the " plaintiffs that the exclusive jurisdiction of " all suits for penalties and forfeitures under " the customs laws of the United States con- " tinued in the District Courts until the pas- " sage of the act of March 3, 1875, entitled " 'An Act to determine the jurisdiction of " the Circuit Courts of the United States, Ch. " 137, 18, Stat. 470, and still continues, unless " the act mentioned gives concurrent jurisdic- " tion of such suits to the Circuit Courts. The " plaintiffs insist that such is the effect of the " first section of the act of March 3, 1875. " That section provides: 'That the Circuit " Courts of the United States shall have origi- " nal cognizance, concurrent with the Courts " of the several States, of all suits of a civil " nature, at common law or in equity, where " the matter in dispute exceeds, exclusive of " costs, the sum or value of five hundred dol-

" lars, arising under the Constitution or laws
" of the United States,' 'or in which the United
" States are plaintiffs or petitioners, &c.' The
" contention is that this section invests the
" Circuit Courts with jurisdiction, concurrent
" with the District Courts, of all suits for pen-
" alties and forfeitures under the customs laws
" of the United States. The argument to sup-
" port the contention is that the section includes
" within its terms all suits to recover penalties
" and forfeitures, because such suits are of a
" civil nature at common law and the United
" States are plaintiffs; and when the amount
" in controversy is over $500 all the conditions
" necessary to give jurisdiction are fulfilled.

" Admitting the plausibility of the argument,
" we are not able to adopt the conclusion to
" which it leads. For more than three-quar-
" ters of a century, under the ninth section of
" the Act of 1789, the exclusive jurisdiction of
" the District Courts, in suits for penalties and
" forfeitures under the customs laws was un-
" questioned. In The Cassius, 2 Dall., 365, de-
" cided in 1796 by the United States Circuit
" Court for the District of Pennsylvania, and
" in Evans *vs.* Bollen, 4 Dall., 342, decided by
" this Court in 1800, it was held that under the
" Judiciary Act of 1789 the Circuit Courts had
" no jurisdiction of suits for penalties and for-
" feitures under the laws of the United States.
" These decisions have never been overruled,
" and the law has remained unchanged, except
" where jurisdiction of suits for penalties and
" forfeitures has been given to the Circuit
" Courts in special cases by statute. This con-
" struction of the ninth section of the Act of
" 1789 prevailed, notwithstanding the pro-
" visions of section eleven of that act, which
" were as follows: 'The Circuit Courts shall

"have original cognizance, concurrent with the "Courts of the several States, of all suits of a "civil nature, at common law or in equity, "when the matter in dispute exceeds, exclu- "sive of costs, the sum or value of five hun- "dred dollars, and the United States are "plaintiffs or petitioners' (1 Stat., 78). This "is substantially the same in respect of the "question before us, as the first section of the "Act of 1875, which is relied on to take away "the exclusive jurisdiction of the Circuit "Courts. But it was never supposed that "under the Act of 1789 the provisions of Sec- "tion 11 interfered with the exclusive juris- "diction conferred on the District Courts by "Section 9 of the same act. It was never held "that the words, 'all suits of a civil nature, "at common law or in equity,' used in Section "11, included suits for penalties and forfeitures "of which the District Courts had been given "exclusive jurisdiction by Section 9. How "then, can the substantial re-enactment of "Section 11 by the Act of March 3, 1875, "with modifications immaterial, as far "as the question in hand is concerned, "have an effect which the original section did "not? As said by the Circuit Court in its "well considered opinion in this case, 11 Fed. "Rep., 476, 'the restricted meaning attached "for eighty-six years to the language of the elev- "enth section of the Act of 1789, is presumed "to attach to the same language in the Act of "1785.' It is not to be supposed that Congress, "in using in the Act of 1875 the same lan- "guage, so far as the present question is con- "cerned, as that employed in the Act of 1789 "intended to give it a meaning different from "that put upon it by this Court, and which

" had remained unchallenged for three-quar-
" ters of a century."

In *Lees* vs. *United States*, *150 U. S.*, *476*, the question arose whether the District Courts had jurisdiction to recover a penalty imposed by the Act of February 26th, 1885 (23d St., 332, Ch. 164), prohibiting the importation and migration of foreigners and aliens under contract or agreement to perform labor in the United States. The third section of the act provided that the offender shall pay for such offense the sum of one thousand dollars, to be sued for as debts of like amount are now recovered in the Circuit Courts of the United States. The Court said:

" From the earliest history of the govern-
" ment the jurisdiction over actions to recover
" penalties and forfeitures has been placed in
" the District Court. The ninth section of the
" Judiciary Act of September 24, 1789, 1 Stat.
" 73, 76 C. 20, provided as follows: 'The
" District Court shall have exclusive original
" cognizance * * * of all suits for penal-
" ties and forfeitures incurred under the laws
" of the United States.' While in the Revised
" Statutes the word 'exclusive' was omitted,
" the language was not otherwise substantially
" changed. It is true that in some cases juris-
" diction over matters of penalty and forfeiture
" has been committed to the Circuit Court,
" but this was always done by special act, and
" does not otherwise affect the proposition that
" the general jurisdiction over actions for pen-
" alties and forfeitures has been and is vested
" in the District Court. Hence, when, as here,
" a statute imposes a penalty and forfeiture,
" jurisdiction of an action therefor would vest
" in the District Court, unless it is in express

" terms placed exclusively elsewhere. If the " words, 'as debts of like amount are now re- " covered' were omitted from this last clause, " the construction claimed by counsel might be " sustained; jurisdiction would then be given " to the Circuit Courts. So, if those words " were in parenthesis, or even separated " from the last part of the clause by a comma, " or any similar punctuation, there would be " plausibility in contention; but taking the " clause as a whole, giving force to all its words, " it would seem to refer to the form of the " action rather than to the forum. When it " is remembered that a penalty may be recov- " ered by indictment or information in a crim- " inal action, or by a civil action in the form " of an action of debt, and also that the Cir- " cuit Courts of the United States are, as con- " tra-distinguished from the District Courts, " the Federal Courts of the original civil juris- " diction, the significance of this clause is " clear. It in effect provides that, although " the recovery of a penalty is a proceeding " criminal in its nature, yet in this class of " cases it may be enforced in a civil action, and " in the same manner that debts are recovered " in the ordinary civil Courts. Repeals by im- " plication are not favored, and the general " grant of jurisdiction to the District Courts of " suits to recover penalties and forfeitures " should not in any case be transferred exclus- " ively to the Circuit Courts by words of " doubtful import. In United States *vs.* " Mooney, 116 U. S., 104, a somewhat similar " effect was made to construe certain provi- " sions of a statute as divesting the District " Courts of their general jurisdiction over suits " to recover penalties and forfeitures; but, in " the face of language more significant of a

" change than that here presented, this court
" sustained such jurisdiction."

The only case we have been able to find in seeming conflict with this contention is *Taft* vs. *Stephens Lith. & Eng. Co., 37 Fed. Rep. 726* (decided in 1889).

That was a *qui tam* action brought in the Circuit Court to recover a penalty under section 4963 of the Revised Statutes and a plea to the jurisdiction of the Court was interposed. Judge Thayer held, that " by section 9 of the Judiciary Act of 1789, United " States District Courts were given jurisdiction ' of " all suits for penalties and forfeitures incurred " under the laws of the United States.' This " clause has ever since continued in force and re- " appears in the Revised Statutes of the United " States as Subdivision 3 of Section 563. Statutes " to recover penalties imposed by the laws of the " United States must accordingly be brought in " the United States District Court, unless jurisdic- " tion to recover the particular penalty is vested " in the Circuit Courts by the statute imposing the " penalty. *It is claimed by the plaintiff's attor- " ney that jurisdiction of suits, to recover penal- " ties imposed by section 4963 is vested in " the United States Circuit Courts by the " ninth clause of section 629, Rev. St. " U. S., which gives that jurisdiction of all suits " at law or in equity, arising under the patent " and copyright laws of the United States. If " the claim was based solely on the phraseology of " the ninth clause of Section 629, we should be dis- " posed to overrule it, and to hold that the suits " therein referred to, and over which the Circuit " Court is given jurisdiction, are ordinary civil " suits at law and in equity, to recover damages for " and to restrain infringements of patents and " copyrights and that the clause does not confer*

"*jurisdiction upon this Court over suits of a penal* "*character; that is, of suits brought to recover* "*penalties imposed by the patent and copyright* "*laws*" (italics ours).

Judge Thayer, however, held that it was to be inferred that the revisors in drafting the ninth clause of Section 629 did not intend to disturb the jurisdiction over certain penal actions vested, by the Act of 1870, in the Circuit Courts (16 St. at Large, 206, 215).

This reasoning we submit, with great respect, is fallacious. Prior to the Act of 1870, the general language vesting jurisdiction in the Circuit Courts over all actions, suits, controversies and cases at law or in equity arising under the patent or copyright laws of the United States, was held not to confer jurisdiction over actions to recover penalties, and when in the revised statutes the jurisdiction of Circuit Courts was restated in language substantially similar, the same construction must be given to said language. Had the revisors intended to incorporate the provisions of 1870 in the revision of 1874, they would have done so in express language and not resorted to words which had received a construction that did not include jurisdiction over actions for penalties.

But for the act of 1870 Judge Thayer manifestly would have held that the general language vesting jurisdiction in the Circuit Courts of actions at law or in equity arising under the patent or copyright laws of the United States, did not include actions to recover penalties.

An elementary rule of statutory construction is that the words of an act will receive the same construction the Courts have given to similar words in a prior enactment. This rule is especially applicable in this case because the revisors must have been aware of the construction which the Federal Courts had given to the provision vesting jurisdic-

tion in the District Court of actions to recover penalties and forfeitures.

Another rule of statutory constructions which clashes with Judge Thayer's conclusion is, that a *special* law giving the District Courts express and specific jurisdiction over *all* actions to recover penalties and forfeitures under *any* of the laws of the United States, is not superseded or affected by the *general* act giving the Circuit Courts general jurisdiction of suits at law or in equity in patent and copyright cases.

We doubt that Mr. Daly's counsel would have commenced this action in the Circuit Court had he not, as he stated in his affidavit on the motion for a new trial, believed that it was for damages (p. 86, fol. 197).

Of course this objection which goes to the jurisdiction of the Court, can be taken any time and renders the judgment *coram non judice.*

Colorado Co. *vs.* Turk, 150 U. S., 138.
Elder *vs.* Richmond Co., 19 U. S. App., 118.

II.

The statute being penal in its nature, must be strictly construed. Accordingly, the penalty is incurred only when substantially the whole of a copyrighted play is produced—and not when merely a single incident in one of the acts is represented.

Had the appeal taken to this Court in the equity suit not been dismissed for irregularity in the manner in which it was brought here, and had there been a review upon the merits, we ven-

ture to believe that it would not have been held by this Court, that the mere incident of a rescue by a third person, instead of the imperilled person saving himself, is of itself the subject of copyright.

Curtis on Copyright, 11.
Chatterton *vs.* Cave, 2 L. R. C. P. Div., 42; on Appeal 3 L. R., Appeal Cases, 483.
Haufstaengen *vs.* Empire Palace (No. 1), 7 Rep., 375;
Haufstaegen *vs.* Empire Palace (No. 2), 2 *Id.*, 385.
Hollinrake *vs.* Transwell, *Id.*, 568.
Paige *vs.* Widen, 20 L. T. N. S., 435.
Cable *vs.* Marks, 42 *Id.* (Chan. Div.), 432.
Perris *vs.* Heximer, 99 U. S,, 674.
Higgins *vs.* Keuffen, 140 *Id.*, 428.
Stowe *vs.* Thomas, 2 Wall. Jr., 547.
Martinetti *vs.* Maguire, 1 Abb. U. S., 536.
Freleigh *vs.* Thompson, First Cir. East. Div., N. Y., rept'd; 2 Morgans' Law of Literature, 319.
Ehret *vs.* Pierce, 10 Fed. Rep., 553.
Serrano *vs.* Jefferson, 33 *Id.*, 265.
Griggs *vs.* Perrin, 49 *Id.*, 15.
Fuller *vs.* Bemis, 50 *Id.*, 926.

But even if the incident can be protected in equity it does not follow that the party using it incurs the penalty fixed by the statute for violating a copyrighted book or play. The play which was copyrighted was Daly's dramatic composition entitled "Under the Gas Light, a Romantic "Panorama of the Streets and Homes of New "York," in five acts (p. 37, fol. 65). In the third scene of the fourth act of said play a miniature train of cars crosses the stage and one of

the characters, in danger of his life from the passing train, is rescued from such danger by another person. *The defendant's play, "After Dark," is in every respect dissimilar in characters, plot, dialogue and scenes*, excepting that in one of the acts there is likewise a scene in which one of the characters, in danger of his life from a passing train, is rescued by another character in the play. It was decided by the Court below that the railroad scene was not original with Daly; nor the passing of trains across the stage, nor the placing of a character in a dangerous position before such passing train, but only the single incident of his rescue from such danger by another.

When the defendant performed the play with the imperilled character staggering from the railroad track without the assistance of a "rescuer" it was held to be no infringement (p. 173 of Record, Daly *vs.* Webster, 4 C. C. A., 10).

The mere incident of a "rescuer" aiding the imperilled person was accordingly enjoined, but it does not follow from this that the defendant is liable at law for the penalties of the statute. The statute is as follows:

"Any person, publicly *performing or representing any dramatic composition* for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns shall be liable for damages therefor, *such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first and fifty dollars for every subsequent performance as to the Court shall appear to be just.*"

The learned trial Judge held, that the statute is a penal one under which the plaintiff was entitled to recover *the penalty* of one hundred dollars for the first and fifty dollars for each subsequent performance, *without regard to the actual damage sustained by him.* He found as a fact that the plaintiff

had received license fees for the production of the said *railroad scene* prior to the said infringements by the defendant, which were not uniform; that they diminished as the play, in process of time, became more familiar to the public and that *ten dollars* was the smallest recent fee that had been paid for its performance and was a reasonable royalty to pay for its use (18).

Indeed the evidence falls short of showing that the railroad scene in Daly's play ever had a definite value in and of itself (166–171).

See Rude *vs.* Westcott, 130 U. S., 153.
Cornelly *vs.* Marckwald, 32 Fed. Rep. 292; affd. 131 U. S., 159.
Warren *vs.* Keep, 155 *Id.* 265–268.
Dobson *vs.* Dorman, 118 *Id.*, 10–17.

On the contrary, when it was transplanted in "Under Currents" the play proved a financial failure (p. 168.)

But, notwithstanding the finding that for the *entire* railroad scene, ten dollars would be a reasonable royalty, the Court found itself obliged to allow for the incident of the rescue one hundred dollars for the first and fifty dollars for each subsequent performance, because the statute was penal in its nature (30–32). After that decision was rendered, Mr. Justice Shiras of this Court reached the same conclusion.

Wheeler *vs.* Cobbey, 70 Fed. Rep., 487.

See also

Lyman *vs.* Boston & A. R. Co., *Id.*, 409.
Merchants' Bank *vs.* Bliss, 35 N. Y., 412.
Stokes *vs.* Stickney, 96 *Id.*, 326.
Gadseten *vs.* Woodward, 103 *Id.*, 242.

(*b.*) A penal statute must be strictly construed

against the prosecutor, but liberally in favor of the party prosecuted.

Whitaker *vs.* Masterson, 106 N. Y., 277–280.

It provides that the penalty shall be incurred only when the representation of a "*dramatic composition*" *is given. Can this, by judicial construction, be strained to include the representation of an entirely different play, in which there is no similarity of characters, plot, dialogue or scenes, excepting that there is reproduced in one of the scenes the single incident of the rescue in a manner similar to the rescue found in plaintiff's play?* Can the Court interpolate into the statute after the words "dramatic composition" the words, "or any part thereof, or any scene or incident in any scene in the said dramatic composition"?

An almost identical question was passed on by Mr. Justice Curtis in Rogers *vs.* Jewett, 12 Monthly Law Rep., N. S., 393, which was an action for a penalty under the sixth section of the Copyright Act of 1831. The learned Judge said:

> "This is an action of debt for penalties
> "founded on the sixth section of the Copy-
> "right Act of February 3, 1831. The declara-
> "tion, which is demurred to, alleges, in sub-
> "stance, that the plaintiff, having an exclu-
> "sive right to print and publish a certain book,
> "the defendants have printed and published a
> "book *whereof a large part is copied from*
> "*said book of the plaintiff*, and is an infringe-
> "ment of the copyright thereof."
>
> "The question raised by the demurrer is
> "whether the statute penalty is incurred by
> "printing *so much of a book as to amount to*
> "*an infringement of its copyright.*
>
> "The sixth section of the act is as follows:

"That 'if any person or persons from and "after the recording the title of any book or "books according to this act shall, within the "term or terms herein limited, print, publish "or import, or cause to be printed, published "or imported, any copy of such book or books "without the consent of the persons legally "entitled to the copyright thereof, first had "and obtained in writing, signed in the "presence of two or more credible witnesses, "or shall, knowing the same to be so printed "or imported, publish, sell or expose to sale, "any copy of such book, without such consent "in writing; then such offender shall forfeit "every copy of such book to the person legally, "at the time, entitled to the copyright thereof; "and shall also forfeit and pay fifty cents for "every such sheet which may be found in his "possession, either printed or printing, pub- "lished, imported or exposed to sale contrary "to the intent of this act, the one moiety "thereof to such legal owner of the copyright "as aforesaid, and the other to the use of the "United States, to be recovered by action of "debt in any Court having competent juris- "diction thereof.'

"The question depends on the meaning of "the words 'shall print,' &c., 'any copy of "'such book or books.'

"What Lord Mansfield said in Mellen *vs.* "Taylor, 4 Burr, 2311, was the technical mean- "ing of the word copy, viz., the incorporeal "right to the sole printing and publishing "cannot have been the sense in which that "word copy is here used. It means transcript; "and the only doubt is whether the thing "complained of must be a transcript of the "entire book, or whether the penalty is in-

" curred by printing of so much of it as " amounts to an infringement of its copyright.

" The words 'a copy of a book' naturally " import a transcript or copy of the entire " book.

" By the fourth section of this act, the ap- " plicant for a copyright of a book must de- " liver to the clerk of the District Court, 'a " 'copy of the same.' No one would suppose " this condition complied with by a delivery of " a copy of less than the entire book; and it " would hardly consist with that principle " which requires penal laws to be construed " strictly, if I were to hold that the words 'a " 'copy of a book' meant only a copy of the " entire book in the fourth section, which con- " fers a privalege, and meant not only this, but " also a copy of any such part of a book as " would infringe its copyright in the sixth sec- " tion, which inflicts a penalty.

" *To construe the act as the plaintiff claims* " *it should be construed would be, in effect, to* " *insert in it, after the words 'copy of a book,'* " *the very important addition, 'or any sub-* " *'stantial and material part thereof suf-* " *'ficient to infringe its copyright.' This* " *enlargement of a highly penal law, so as to* " *extend it to a large class of cases not de-* " *scribed in it, is inconsistent with the sound-* " *est principles of interpretation.*

" *I am not only unable to say that Congress* " *did intend to inflict these penalties on the* " *unlawful publication of parts of a copy-* " *righted book, because they have failed to say* " *so; but I think it clearly appears, from a* " *comparison of the act of May 31, 1790, with* " *the provisions of this act, by which it has* " *been revised and repealed, that Congress* " *did not intend to inflict these penalties upon*

" *the unlawful printiny or publication of less*
" *than an entire book.*

" The second section of the Act of 1790 pro-
" vided for penalties for the printing, &c., of
" any copy or copies of any map, chart, book
" or books, without the consent of the pro-
" prietor. Maps, charts and books are here
" all included in the same section and subject
" to the same provisions.

" When this act was revised and repealed by
" the Act of 1831, the provisions of its second
" section are divided and changed.

" The unlawful printing of books is pro-
" hibited under penalties by this sixth section,
" now under examination.

" The unlawful making of maps, charts, en-
" gravings, prints and musical compositions is
" prohibited under other penalties by the
" seventh section.

" The sixth section, in describing the offense,
" uses the language of the act of 1791, ' print,'
" &c,, ' any copy of such book or books ;' the
" seventh section materially changes this ; its
" language is, ' engrave, etch or work, &c.,
" ' either on the whole, or by varying, adding
" ' to or diminishing the main design, with in-
" ' tent to evade the law ; or shall print,' &c.,
" ' any such map.' &c., or ' any parts thereof.'

" This makes it plain that, in enacting this
" law, Congress did intend to inflict penalties
" on any such piracy of the copyright of a
" map, chart or engraving, as would amount
" to an infringement of the copyright ; and, so
" intending, that the appropriate language
" was used to express the intent. In the pre-
" ceding section, touching books, all such lan-
" guage being omitted, the inference is obvious
" and strong, that it was not intended to in-

"clude cases of copying parts of a book, but "only the republication of the whole.

"It was argued that this construction would "render the law of little utility, because it "would be easy to omit some unimportant "parts, and thus escape. Whether such omis- "sion would evade this law, I am not called "on to decide. If it did, literary property "would be better protected than the rights of "inventors; for they can only have their pri- "vate remedies at law and in equity, if their "inventions are substantially copied. And "authors have not only these private remedies, "but they who attempt to offer to the public "reprints of their works are subjected to severe "penalties. Whether these penalties should "be imposed on those who offer some parts of "their books to the public is for the legisla- "ture to determine.

"As to maps, charts, engravings, prints and "musical compositions, the Legislature has "thought proper to have the penalties applied "to any unlawful copy of such work made "with design to evade the law. But no such "intention is manifested in regard to unlaw- "ful copies of parts of books.

"So far as I know, the question arising in "this case has not been authoritatively de- "nied.

"It was raised in the Circuit Court in the "case of Backus *vs.* Gould, 7 How., 798, and "was ruled *pro forma* by the Circuit Court of "New York. But the Supreme Court did not "have occasion to pass upon it, that case hav- "ing been decided on another ground" (italics ours).

This Court, in Sparf *vs.* United States, 156 U. S., at p. 74, referred to the Justice who wrote that

opinion as "that eminent jurist, whose retirement from judicial station has never ceased to be a matter of deep regret to the bench and bar of this country."

That is the only case in which the question, so far as we have been able to discover, has been patly presented, and while it relates to a "book" manifestly the same rule should be applied to a dramatic composition. Indeed, in the statute a dramatic composition is included in the generic term "book"

Thus Section 4962 provides that no person shall "maintain an action for the infringement of his "copyright unless he shall give notice thereof by "inserting in the several copies of every edition "published on the title page, or the page im- "mediately following, if it be a *book*, or if a map, "chart, musical composition, print, cut, engraving "photograph, painting, drawing, chromo, statue, "statuary or model or design intended to be per- "fected and completed as a work of the fine arts, by "inscribing upon some portions of the face or front "thereof, or on the face of the substance on which "the same shall be mounted, the following words: "'Entered according to Act of Congress, &c.'"

In U. S. *vs.* Trans-Missouri Freight Asso., 116 U. S., 290, the statute prohibiting the making of a contract in restraint of trade, being under review this Court held that it includes every contract whether in reasonable or unreasonable restraint of trade. The Court said it had no power to restrict or enlarge the unambiguous language used by Congress; that if it be advisable to permit contracts in reasonable restraint of trade, that argument should be addressed to the legislative branch of the government. So here; the act is clear in imposing a penalty only when a dramatic composition is performed. If it be desired to impose the same extreme penalty, when only a single incident is rep-

resented, the appeal should be made to Congress. To read the statute as though the words "or any part thereof" followed the words "dramatic composition" would not be construing the law, but in, the language of Justice Curtis, would be judicial legislation,

In this case, the plaintiff asks the Court to construe the statute with even greater looseness than the English statute has been construed. The English law imposes a penalty of "not less than forty shillings" for the representation of a dramatic composition *or any part thereof* (3 and 4 Will., IV, C. 15, § 2), but the words, "or any part thereof," have been construed to mean *a substantial and material part* of the play (Chatterton *vs.* Cave, 3 Appeal Cases, 489). In the case at bar, not a syllable of evidence was introduced that the *manner of the rescue* is a material or important part of plaintiff's play; the evidence related to the value of the *entire railroad scene.* To state the proposition differently there is not a word of proof that the railroad scene could not be just as effectively performed if the character, who is in danger of his life, saves himself by staggering off the track or falling against the switch and side-tracking the train, or in some other way, that does not require the presence or assistance of another person. The defendant used a "rescuer" only after Judges Wallace and Coxe decided that Daly's copyright was invalid.

(*c.*) In the Court below, Daly's counsel argued, and the Circuit Court of Appeals held, that said incident of the rescue is a "dramatic composition." As we understand counsel's contention it is that a book may contain several independent or connected dramatic compositions and that the railroad scene is a dramatic compostion in and of itself.

We submit that the railroad incident without the

play is not a "dramatic composition" within the meaning of the statute ; and the mere incident of pushing or lifting a character from a railroad track, is certainly not.

See Martinetti *vs.* Maguire,
Haufstaeugen *vs.* Empire Palace,
Chatterton *vs.* Cave,
Hollinrake *vs.* Transwell,
Paige *vs.* Widen,
Fuller *vs.* Bemis,
Freely *vs.* Thompson,
Baker *vs.* Seldin,
Perris *vs.* Heximer, cited above.

The Court below held that the equity suit determined that the railroad scene was a dramatic composition (page 176), and counsel argued, that in this the decision followed the decision in Daly *vs.* Palmer (6 Blatch, 256 ; S. C. 36 How. Pr., 206).

In the equity case, as in Daly *vs.* Palmer, the question was simply whether equity would enjoin the infringement of a scene, which was a part of Daly's copyrighted book or play.

The Court said in the Palmer case :

> " Under the Act of 1856, construed in connec-
> " tion with the Act of 1831, he (the proprietor
> " of the copyright) is entitled to be protected
> " against piracy in whole or in part, by rep-
> " resentation as well as by printing, publish-
> " ing and vending. Although the Act of
> " 1831, in regard to printing, publishing and
> " vending, uses the words, 'in whole or in
> " part,' and the Act of 1856, in regard to
> " representing, does not use those words, yet
> " the Act of 1856, by referring, as it does, to
> " the right conferred by the Act of 1831, is the
> " 'sole right to print and publish' the copy-
> " righted composition, when such right is on

"the face of the Act of 1831, the sole right "print and publish 'in whole or in part,' and "by then conferring 'the sole right also to "act, perform or represent the same, or to "cause it to be acted, performed or repre- "sented on any stage or public place,' must "be held to confer the right to represent in "whole or in part."

In this connection it should be remembered that in the Palmer case the entire railroad scene was enjoined, whereas in the equity suit against Brady it was held that nothing was original with Daly but the incident of the rescue by another character.

In equity it is sufficient to show the taking of a part of copyrighted work without authority, but it by no means follows that such an infringer is liable for the penalty imposed for the wrongful representation of the entire play. Had the defendant taken the title of Daly's play and used it for another and different play, equity would unquestionably have enjoined him from so doing, but he would not be liable for the penalty under this statute.

Judge CURTIS, in the Rogers case (*supra*), answering the argument that such a construction would help a person to evade the law, said:

"It was argued that this construction would render the law of little utility, because it would be easy to omit some unimportant parts and thus escape. Whether such omission would evade this law, I am not called on to decide. If it did, literary property would be better protected than the rights of inventors; for they can only have their private remedies at law and in equity, if their inventions are substantially copies. *And authors have not only these private remedies*, but they who attempt to offer to the public reprints of their works, are subjected to severe penalties.

Whether these penalites should be imposed on those who offer some parts of their works to the public, is for the Legislature to determine" (italics ours).

Counsel's argument that if several dramatic compositions were copyrighted as one book, under our contention the penalties could not be enforced unless all the dramatic compositions in said book were performed begs the question. If any one of the dramatic compositions were performed in its entirety there would be little difficulty in holding that a copyrighted dramatic composition was infringed on and that the penalties were incurred.

Again, the railroad scene is not what Daly copyrighted. He copyrighted a play in five acts, to which he affixed the title of, "Under the Gas-Light, a romantic panorama of the Homes and Streets of New York." The statute renders a party liable who publicly performs and represents without authority that dramatic composition.

If counsels contention be correct Daly can recover these extremely heavy penalties under said statute for the use of merely the incident of the rescue, while if the action had been brought to recover damages or profits, he could recover only such as were earned from the use of said incident.

Warren *vs.* Keep, 155 U. S., 265-268.
Dobson *vs.* Dornan, 118 Id., 10-17.

III.

The Court below erred in permitting the defendant's answer in the equity suit to be used against him in this action.

(*a.*) It is only fair to repeat that in our opinion

this ruling would not, in all probability have been made but for the contention of plaintiff's counsel during the first trial that this action was for damages, and that the rules of evidence applicable to a common law action for damages and not those applicable to an action for penalties should be applied. He alleged in his affidavit upon the motion for a new trial that " he believed that this action was an action for damages, and could be sustained without reference to the clause in the statute which was alleged to be penal in its nature," and that " the decision of the Court (upon the first trial) has taken him by surprise " (96).

Upon that theory he introduced in evidence on the first trial the defendant's answer, Master's report and the decree, and urged that all evidence on the part of the defendant touching plaintiff's copyright or the infringement be ruled out as *res adjudicata* (35-63-70-77). When, after the submission of briefs and an examination of the law, the learned trial Judge decided that the action could not be sustained as an action for damages, but only as an action to recover penalties it clearly became error to admit in evidence the verified answer of the defendant in the equity suit.

Section 860 of the U. S. R. S. provides that " *no pleading of a party, nor any discovery of evidence obtained by means of a judicial proceeding in this or any foreign country, shall be given in evidence or in any manner used against him or his property or estate in any Court of the United States, in any criminal proceeding or for the enforcement of any penalty or forfeiture*, provided that this section shall not exempt any party or witness from prosecution and punishment for perjury committed in discovering or testifying as aforesaid."

The use of the pleading in evidence or *in any*

manner in an action "for the enforcement of any penalty is thus plainly prohibited." Nothing can be broader, no language more expressive, and yet the defendant's answer in the equity suit was read in evidence against him in this action (Plaintiff's Exhibit 1B, 43). It had to be verified (see Amendment to Bill of Exceptions, p. 166), as the complainant refused to waive the oath (42). When the record including the said answer was offered, objection was taken (35); again when plaintiff rested (62) and at the close of the case (77). It was again urged by exceptions to the findings (147) and assigned as error (153-154).

In Boyd *vs.* The United States, 116 U. S., 616, this Court said, at p. 634:

> "The information, though technically a civil proceeding, is in substance and effect a criminal one. As showing the close relation between civil and criminal proceedings on the same statutes in such cases, we may refer to the recent case of Coffey *vs.* The United States (*ante*, 436), in which we decided that an acquittal on a criminal information was a good plea in bar to a civil information for the forfeiture of goods, arising from the same acts. As, therefore, suits for penalties and forfeitures incurred by the commission of offenses against the law are of this *quasi* criminal nature, we think that they are within the reason of criminal proceedings for all the purposes of the Fourth Amendment of the Constitution, and of that portion of the Fifth Amendment which declares that no person shall be compelled in any criminal case to be a witness against himself; and we are, further, of opinion that a compulsory production of the private books and papers of the owner of goods sought to be forfeited in such a suit is compelling him to be a

witness against himself, within the meaning of the Fifth Amendment to the Constitution, and is the equivalent of a search and seizure, and an unreasonable search and seizure, within the meaning of the Fourth Amendment." * * * and at page 631 :

"Any compulsory discovery by extorting the party's oath or compelling the production of his private books and papers, to convict him of crime, or to forfeit his property, is contrary to the principles of a free government. It is abhorrent to the instincts of an Englisman ; it is abhorrent to the instincts of an American. It may suit the purposes of a despotic power, but it cannot abide the pure atmosphere of political liberty and personal freedom."

Lees *vs.* United States, 150 U. S., 476.

(*b.*) Counsel argued below that the error is not sufficiently presented by the objection. It was presented in every possible form that we could conceive of, and at every stage of the case. *The answer was not offered in evidence separately*, but the entire record in the equity suit was introduced. We thereupon enumerated eight grounds of objection not only specifically that this record could not be used against the defendant in this penal action, but cited authorities to enforce the objection. The court was thus placed in possession of the grounds of our objection (pages 35–36 of record). The objections were again stated when the plaintiff rested (62); and were repeated when defendant rested (77–78). We were likewise explicit in our assignments of error (153–154), and the decision of Judge Shipman on the first trial, when he dismissed the complaint, shows that he clearly understood defendant's position and that the objections were specific enough to inform him of the defendant's contention.

We could not specifically object to the answer because it was not offered in evidence separately, but came in with the record. The record itself was marked "Plaintiff's Exhibit 1," and the different papers constituting the record were marked "Plaintiff's Exhibit 1, a, b, c, etc., for the purpose of convenience. There was no occasion or propriety in raising a separate objection to each paper constituting the record. Both Court and counsel fully understood that the objections to this record included the defendant's answer. The Court of Appeals manifestly ignored the contention that the objection was not sufficiently specific.

(*c.*) Counsel also argued below that this error could not be urged because Brady, in his answer refers to the complaint, final decree and record in the equity suit. Where a defendant after denying the charge made against him sets up affirmative defences based upon a record, there is no rule of law that ma*kes* the record, otherwise incompetent, competent proof of the facts therein contained and sufficient to sustain a conviction in a criminal case. The defendant in a criminal proceeding has a right to base his plea upon a prior trial, conviction or acquittal, but the prosecution cannot *for that reason* claim the right to introduce said record to prove the case against the defendant. The error committed by the Court was brought on by the contention of counsel that the action was at law for damages, and on the first trial said record was admitted on that theory.

Again, the action being at law, the New York State rule as to the form of pleadings prevails. Under the New York practice, inconsistent defenses may be set up.

Societa Italiana *vs.* Sulzer, 138 N. Y., 468.

Goodwin *vs.* Wertheimer, 99 *id.*, 149.

Bruce *vs.* Burr, 67 *id.*, 237.

If, therefore, we were to assume that the affirmative defenses set up in Brady's answer, in which reference is made to the equity decree, are inconsistent with the denials therein contained, Brady cannot be prejudiced thereby, or compelled to elect between his denials and his affirmative defenses. These affirmative defenses were:

(*a.*) That the performances claimed to have been in violation of Daly's rights were not "willful," but given intermediate the decision of Judge Wallace and the reversal by the Court of Appeals; and

(*b.*) That Daly made an election to sue for profits when he filed his equity bill, which was a bar to this action.

It is not inconsistent to contend that the plaintiff has no copyright, and further that the defendant did not willfully violate it, and that plaintiff made an election which bars the action. But even if inconsistent, still under the New York system of pleading, Brady had a right to set up these defenses, and is not to be prejudiced thereby, or driven to make an election which will compel him to waive one or the other of his defenses.

(*d.*) The learned Court below held that there was no harmful error in the admission of said answer, in view of the fact that the record was admitted for certain purposes only, and of the statement of the Circuit Judge that the answer was not used or taken in evidence, in ascertaining any facts as to performance or for the enforcement of any alleged liability in this action (176-177). If the answer were stricken out there would be no basis for the decree in equity on the strength of which the Court excluded Brady's evidence as being barred by the decree (63, 70, 77). Indeed, Daly's case rests wholly upon the record in the equity suit founded upon that answer. With the

exception of his deposition as to royalties received by him, he introduced no other evidence (166-171).

Here was an answer, under oath, which, under the protection of the statute Brady could safely file, *given in evidence in connection with a decree secured in the suit in which it was served.*

The decree founded upon that answer was used in this action to bar the defendant from introducing evidence which would have enabled him to present the questions raised by his answer in this action.

(*e.*) It is argued that said answer did not admit the giving of the infringing performances. The answer *did make admissions*—it admitted defendant's connection with the company which gave the infringing performances. It was charged in the bill that Brady and his co-defendant Webster, with full knowledge of Daly's rights, had been giving infringing performances of "After Dark," in which one of the characters was suspended from an aperture in the top of a tunnel, hanging over the rail where he would be struck by the engine, and is rescued by another character. These performances were stated to have been given in the city of Philadelphia, State of Pennsylvania, at the National Theatre, and that Brady and Webster intended to produce the said play "After Dark," in the city of New York, at the People's Theatre (see Bill of Complaint, Plaintiff's Exhibit 1*a*, pp. 40-41).

In his answer Brady *was obliged to admit his connection with the play, and that he gave the performances at the National Theatre, and that he intended to produce the play at the People's Theatre in the city of New York* (See Answer, Plaintiff's Exhibit 1b, page 43; paragraph 13, p. 48; paragraph 11, p. 47, of Record).

This admission became an important link

in the chain of evidence against Brady, and was made the most of by Daly's counsel. In his brief in the Court of Appeals he refers to the performances in Philadelphia, and the change made in the railroad scene in New York City and argued: "On the 19th day of May, 1889, "the bill in this suit was sworn to by the "complainant, alleging that the scene of the "play of 'After Dark,' as produced by the "defendants, was a colorable imitation of the "scene from 'Under the Gas Light,' and men- "tioning the difference, that Gordon Chumley was "suspended a few inches from the track, by a "rope, instead of being laid, bound upon the "track. The defendants' answer admitted that "the production in Philadelphia was, as it has "been shown to be, but said that the production "of the play in the city of New York varied, as "Gordon Chumley, instead of being rescued from "the track, reels up against the switch and throws "the train off upon another line. * * * It is "perfectly, plain, then that the defendants have "produced and, except so far as they have feared "the orders of the Court, have intended and con- "tinued to produce the play of 'After Dark' pre- "cisely as it was originally written."

Daly's Brief, Circuit Court of Appeals in the Equity suit, pages 27 and 28.

And on said admission the Court of Appeals largely based its decision in favor of the injunction, saying:

"The performances of defendant's play, with "the scene unchanged (although such per- "formances were had after the suit was begun) "*and the performances in Philadelphia be-* "*fore suit*, with the immaterial change above "referred to, of suspending the imperilled per-

"son above the track, sufficiently indicate the "intention on the part of the defendants to "infringe complainant's copyright, unless re- "strained by decree of the Court" (italics ours).

Daly *vs.* Webster, 56 Fed. Rept., 483.

(*f.*) Counsel finally contended in the Court below, that the defendant was not obliged to answer the bill under oath, as he might have demurred. The bill was not demurrable. It was properly framed in equity and the statute protected the defendant against the use of his answer in a penal action. Besides it does not lie in the mouth of the plaintiff, after calling upon the defendant for a verified answer, to urge that he should have demurred to the bill.

IV.

It was error to admit in evidence the record in the equity suit, as proof of the material allegations of the complaint, and to hold that it was res judicata, precluding defendant from introducing evidence that the railroad scene and the manner of the rescue were public property and not original with the plaintiff.

(*a.*) While the equity decree would, perhaps, be conclusive in an action at law, it cannot have such operation in a criminal suit or on a *quasi* criminal action to recover a penalty.

1 Freeman on Judgments, Section 259.

In a suit in equity, the evidence to sustain the decree need only be sufficient to satisfy the conscience of the Court by a bare preponderance,

and the defendant may be compelled to testify and produce his books and papers, and his omission to do so raises a strong presumption against him. In a penal action, however, the plaintiff must make out his case by proof beyond a reasonable doubt, and not only cannot the defendant be compelled to testify and produce his books and papers, but his omission so to do does *not* raise a presumption against him.

"To recover penalties a case must be made out *beyond a reasonable doubt.*" (*Italics ours.*)

Chaffee *vs.* United States, 18 Wallace, 516.

> "If the scale of evidence does not preponderate against him (defendant), if it hang upon a balance the penalty cannot be enforced. No individual should be punished for a violation of law *which inflicts a forfeiture of property, unless the offense shall be established beyond a reasonable doubt.*" (Italics ours.)
>
> United States *vs.* Burdett, 9 Pet., 682.

The statute under discussion (4966) was amended January 6th, 1897, by providing that *in addition to a money penalty* "if the unlawful performance and representation be wilful and for profit, such person or persons shall be guilty of a misdemeanor and upon conviction, be imprisoned for a period not exceeding one year."

Surely on an indictment it could not be contended that a case would be made out by the introduction of a decree in equity, and that it would be *res adjudicata* and bar the defendant out of all defenses. Yet in this quasi-criminal proceeding to recover penalities defendant was convicted and fined to the extent of $6,300 upon substantially such proof.

In Boyd *vs.* United States (*supra*) a statute similar to the one under discussion as amended, pro-

vided for imprisonment and a penalty. Referring to those provisions the Supreme Court said:

> "If the government prosecutor elects to waive an indictment, and to file a civil information against claimants—that is, civil form—can he by this device take from the proceeding its criminal aspect and deprive the claimants of their immunities as citizens and extort from them a production of their private papers, or, as an alternative, a confession of guilt? This cannot be. The information though technically a civil proceeding, is in substance and effect a criminal one. As showing the close relation between the civil and criminal proceedings on the same statute in such cases, we may refer to the recent case of Coffey *vs.* The United States, *ante* 436; in which we decided that an acquittal on a criminal information was a good plea in bar to a civil information for the forfeiture of goods arising upon the same acts."

"An action to recover a penalty or forfeiture though in form a civil action is unquestionably criminal in its nature" (*Syllabus*).

See also Lees *vs.* N. Y., 150 U. S., 476.

A penalty is in the nature of a punishment for the non-performance of an act, or for the performance of an unlawful act, and involves the idea of punishment whether enforced in a civil or criminal action or procedure.

Hall *vs.* Norfolk and Western Co., 41 L. R. A., 669.

In Stowe *vs.* United States, 167 U. S., 178, it appeared that the defendant was indicted criminally for cutting timber from land owned by the government and was acquitted; thereupon the govern-

ment brought an action to recover the value of the timber alleged to have been unlawfully cut by Stowe from its land. He sought to introduce in evidence the record of the criminal proceeding, but this Court said (page 184):

> "In our opinion, the record of the criminal "proceeding in the Court of Idaho *was not* "*evidence to establish or disprove any of the* "*material facts involved in the civil action.*" * * *

The Court, at page 188, says:

> "In the criminal case the Government sought "to punish a criminal offense, while in the civil "case it only seeks, in its capacity as owner of "property illegally converted, to recover its "value. In the criminal case his acquittal "may have been due to the fact that the Gov- "ernment failed to show beyond a reasonable "doubt the existence of some fact essential to "establish the offense charged, while the same "evidence in a civil action, brought to recover "the value of the property illegally converted, "might have been sufficient to entitle the Gov- "ernment to a verdict." * * *

So here in the civil suit, the plaintiff could resort to the defendant's answer under oath, and could also compel his attendance with books and papers, and would be entitled to his decree, if, from the record, he made out a case by a preponderance of evidence, but in this action, "unquestionably criminal in its nature," plaintiff was required to make out his case beyond a reasonable doubt, by common law proof, without calling the defendant or for his books or papers, and with no presumption against him if he failed to testify.

(*b.*) If said record could be evidence at all, of

any of the facts which it was necessary for plaintiff to establish, it certainly was not *conclusive evidence*, so as to bar the defendant from attacking the validity of plaintiff's copyright, or showing that plaintiff was not the inventor of said incident of the "rescue."

Had the evidence offered by the defendant (68-70-77) been admitted, the lower Courts would very likely have followed the previous decision, but the defendant could have secured the benefit of a review by this Court, *which has never been committed to the view* that the mere incident of a rescue, such as the shoving or lifting of a person from a place of danger is of and in itself the subject of copyright monopoly, preventing its representations upon the stage, in any other play without the plaintiff's consent or its use in any story, book or magazine, without his permission.

A defendant may not have the means to defend a suit for an injunction. It would be a novel, and dangerous, doctrine that he has thereby estopped himself from defending himself in a criminal prosecution which may follow.

V.

The performances between the decisions of Judges Wallace and Coxe, holding the copyright invalid, and the reversal by the Court of Appeals were not willful violations of plaintiff's rights and for that reason the statutory penalty was not incurred.

The decision of Judge Wallace was rendered June 19th, 1889 (19); the bill was dismissed on final hearing by Judge Coxe, November 4th, 1891 (19); the Court of Appeals reversed the lower Court, October 4th, 1892 (19). As the performances in

question were given between August 24th, 1891, and October 5th, 1892 (18), it may, with perfect propriety, be said they had the sanction of the Court. Can they then be held to be willful violations of plaintiff's rights, rendering defendant guilty of a crime punishable by the forfeiture of his property. While a *prima facie* case may ordinarily be made out by mere proof of the unauthorized giving of performances, when it appears that they were given under the conditions disclosed in this record, it cannot be said that they were willful. Consequently no forfeiture or criminal punishment can follow, for the reason that the intent, an essential element of criminality, is wanting.

In Cutter *vs.* The State, 36 New Jersey Law, 193, where the defendant, charged with taking fees to which he was not entitled, urged that he did so under a mistake as to his legal rights. Chief Justice BEASELY said (on page 126):

> "On the part of the State it is argued that this statute is explicit in its terms, and makes the mere taking of an illegal fee a criminal act without regard to the intent of the recipient. Such undoubtedly is the literal force of the statute. But then, on the same principle, the officer would be guilty if he took by mistake or inadvertence more than the sum coming to him. Nor would the statutory terms, taken in their exact signification, exclude from their compass an officer who might be laboring under an insane delusion. Manifestly, therefore, the terms of this statute are subject to certain practical limitations. This is the case with most statutes couched in comprehensive terms, and especially with those that modify or otherwise regulate common law offenses. In such instances, the old and new laws are to be construed together, and the former will not be

considered abolished, except so far as the design to produce such effect appears to be clear. In morals, it is an evil mind which makes the offense, and this, as a general rule, has been at the root of the criminal law. The consequence is, that it is not to be intended that this principle is disregarded merely on account of the generality of statutory language. It is highly reasonable to presume that the lawmakers did not intend to disgrace or to punish a person who should do an act under the belief that it was lawful to do it; and it is this presumption that fully justifies the statement of Mr. Bishop 'that a statute will not generally make an act criminal, however broad may be its language, unless the offenders intent concurred with his act'" (Crim. Law, 80).

In Lusby *vs.* Kansas City M. & B. R. Co., 36 L. R. A., 510, it was held: That a party relying upon the decision of the Court of last resort in a State, cannot, although the decision is afterwards repudiated, be regarded as acting willfully or maliciously, within the meaning of a statute prescribing a penalty for willful trespass.

It is true that the statute under discussion does not expressly provide that the representation or performance must be "willful" but that is necessarily implied.

In an action to recover a penalty, the wrongful intent is a material ingredient of the offense. Though the Circuit Court on final hearing decided that it was no violation of Daly's copyright to give these performances, when that decision was reversed by the Court of Appeals, an injunction was properly issued. There having been an infringement, equity would not permit its continuance, no matter how innocent the intent, but

when it comes to punishing Brady by the infliction of penalties, the additional ingredient of a wrongful intent must be found, and when it appears that the performances complained of were given subsequent to a decision of the Court, holding that they were lawful, that element is missing.

In Harper *vs.* Shoffell, 26 Fed. Rep., 519, the question is passingly alluded to as follows: "The defendant has not *intentionally* infringed the plaintiff's rights, and, *therefore*, nominal damages only are claimed" (italics ours).

Even in a common law action, where *punitive* damages are sought, guilty intent must be shown.

Lake Shore, &c., Ry. Co., *vs.* Prentiss, 147 U. S., 101.

In that case the Court, at page 107, says:

> "In this Court the doctrine is well settled
> "that in actions of tort, the jury, in addition
> "to the sum awarded by way of compensation
> "for the plaintiff's injury, may award exem-
> "plary, punitive or vindictive damages, some-
> "times called smart money, if the defendant
> "has acted wantonly, or oppressively, or with
> "such malice as implies a spirit of mischief, or
> "criminal indifference to civil obligations.
> "*But such guilty intention on the part of the*
> "*defendant is required in order to charge*
> "*him with exemplary or punitive damages*"
> (italics ours).

The rule is clearly stated by Judge Coxe in Willing *vs.* Le Bau (35 Fed. Rep., 302):

> "In a suit for infringement of a patent where
> "the defense, though active and annoying to
> "complainant has not been in a legal sense
> "wanton or unjustifiable, *the defendant hav-*
> "*ing unquestionably considered himself in*

" *the right and having acted fairly and hon-*
" *estly toward his adversary*, a motion for the
" Court to increase the damages as it is al-
" lowed in its discretion to do under Rev.
" St. U. S. Secs. 4919, 4921, should not be
" granted " (Syllabus, italics ours).

Manifestly the application of the same rule is proper where, for the use of a single incident, a recovery is sought in an amount ten times greater for the first and five times greater for each subsequent performance than plaintiff received *for permitting the performance of his entire play* (166–171).

VI.

The Court erred in refusing to hold that the plaintiff, by first proceeding in equity for an accounting of profits, made an election barring him from a recovery for penalties.

The bill in equity prayed, among other things, that the "defendants be decreed to render a full and true account to your orator, of all moneys and profits received through or by reason of the said performances of the said play of 'After Dark' and of the railroad scene therein" (42). And the Court of Appeals "remanded the cause, with instructions to enter *the usual decree for an accounting and perpetual injunction*" (53). John E. Ward was thereafter appointed Master to take proof of the number of performances given by the defendants (54). Having thus elected to sue for the profits, Daly cannot when he finds that he can recover no profits turn the action into one for the recovery of the statutory penalties.

The soundness of this contention is emphasized

by the legislation relating to patents. Before the passage of the Act of 1870, the owner of a patent was restricted either to an accounting of profits, OR to damages. He could not recover both. That was also the rule in England. In De Vitre *vs.* Betts (6 House of Lords, 319), it was held that the complainant was *bound to elect* whether to prosecute for profits or damages, and *an election of one constituted a waiver of the other. That was also the rule in the United States until the amendment of 1870.*

Root *vs.* Railway Co., 105 U. S., 189, 209, 212.

But the right given to a patentee by that amendment (Sec. 53) to recover "in addition to profits the damages sustained," was not extended to the owner of a copyright.

In Stevens *vs.* Gladding (2 Curtis, 608), CURTIS, J., said:

> "*If the proprietor will waive his action for* "*damages, he may have an account of profits,* "upon the ground that the defendant has, by "dealing with his property, made gains which "equitably belong to the complainant. And "I perceive no sound reason for restricting "those gains to the difference between the "cost and the sale price of the map or book, "or limiting the right to an account to those "persons who have sold the work solely on "their own account. He who sells on commis-"sion does, in truth, sell on his own account, "so far as he is entitled to a percentage on the "amount of the sales. What he so receives is "the gross profit coming to him from the pro-"ceeds of the sales. And what he so receives "diminishes the net profits of the one who "employs him to sell. When the latter is

" called on to account, he has an allowance for " the commissions he had paid, because those " sums, though part of the gross profits of the " sales, he has not received. That part of the " profit of the sales being in the hands of the " commission merchant, the consignor is not " accountable for them. But why should not " the commission merchant, who has them, " *account for them? He was liable to an ac-* " *tion for damages for selling. That right is* " *waived.* I think he should pay over to the " proprietor, in lieu of damages, the gain he " has made from the sales. It does not seem to " me that the term profits necessarily, or when " construed in reference to the subject matter, " properly, had so restricted a meaning as to " exclude commissions received from the pro- " ceeds of the sales of the property of the com- " planant " (italics ours).

See also Morss *vs.* Knapp, 35 Fed. Rep., 218 (Circuit Court, Conn.).

As already stated, it is not of the slightest importance that there was no recovery of profits upon the accounting.

In Conrow *vs.* Little (115 N. Y., 387), the Court said :

" It is not at all material to the question that " the plaintiff discontinued the first suit before " bringing the present to trial, for it is the " fact that the plaintiffs elected this remedy " and acted affirmatively upon that election. " *That determines the present issue.* Taking " any step to enforce the contract was a con- " clusive election not to rescind it on account " of anything known at the time. After that " the option no longer existed, and it *is of no* " *consequence whether or not the plaintiff* " *made the choice effective* " (italics ours).

In Bach *vs.* Tuch (126 N. Y., 53), the plaintiffs having sold goods on credit induced by the fraudulent representations of the defendant, first commenced an action on contract to recover the purchase price, and nothing being recovered discontinued and brought an action *in tort* to recover possession of the goods; held that plaintiffs by their first action made an election which was final and irrevocable.

In the case at bar plaintiff made the election with full knowledge of the facts. Having the alternative to sue for an injunction *and* for profits down to the time of the entry of the decree, or sue for an injunction *only*, which would leave him free to sue for the statutory penalty he adopted the former remedy. He is bound by the election.

In Interlied *vs.* Whaley (85 Hun, 68) plaintiff proceeded in equity to enjoin defendant from depositing sawdust in a stream and obtained a decree for a perpetual injunction *without any damages*. Thereupon an action at law was commenced by him to recover the damages he sustained *after the commencement of the equity suit but before the final decree.* The Court carefully reviewing the authorities reached the conclusion concisely stated in the syllabus as follows:

> "The damages recoverable in an action at
> "law are limited to such as occurred prior to
> "the commencement thereof, but in an action
> "in equity, where the plaintiffs seek to obtain
> "a permanent injunction forbidding the com-
> "mission by the defendants of certain alleged
> "wrongful acts and trespasses, and allege
> "damages as incidental to the equity relief,
> "the plaintiffs are entitled, under a proper
> "state of facts, to recover all damages sus-
> "tained up to the time of the rendering of the
> "decision made in that action, upon which

"judgment was entered by reason of the "wrongful acts of the defendants.

"They are entitled to recover such damages "as would necessarily and naturally result "or be incurred from the injury complained "of.

"The judgment recovered in such action "would be a bar to the maintenance of an ac- "tion at law to recover damages sustained by "the plaintiffs since the making of the decree "in the prior action by reason of the alleged "wrongful acts of the defendants, if such acts "were done prior to the making of the decree "in the first action" see also Root *vs.* The Railway Co., 105 U. S., 187, at pp. 198-201).

It was manifestly in pursuance of the prayer in the bill, and the mandate of the Court of Appeals, "to enter the usual *decree for account*" (page 53), that the matter was sent to a master to take and state an account of the number of times the railway scene was used and produced by the defendant, and where each performance took place, and the terms and agreements under which it took place (54).

VII.

The Court below committed error in limiting the defendant upon the new trial to proof as to the number of performances.

With the utmost respect we venture to assert that no authority can be found justifying the order of the Trial Court granting the plaintiff a new trial. It seems to have been based upon the mere statement of counsel that he was mistaken in the nature of his action, had not properly prepared his case, and was, therefore, surprised at the result (85). He did not bring himself within the

rules governing the granting of new trials. His motion was not founded upon newly discovered evidence, and it is not pretended that there was a witness in Court, whom he failed to call, because of the ruling admitting the records in evidence. If error was committed at the first trial, *it was because the Court* was misled by counsel's contention that the action was for damages and not to recover penalties. The decision establishes a new and dangerous practice under which counsel may try a case upon one theory, and if defeated, get a second opportunity to try it upon a different theory. Such gambling should not be allowed, and is condemned by the authorities.

Palmer *vs.* Fisk, 2 Curtis, 14.
Codman *vs.* Vermont, &c., Co., 17 Blatch., 1 (see p. 3).
Carr *vs.* Gale, 1 Curtis, 384.
Aimes *vs.* Howard, 1 Sumner, 482 (Story, J., see p. 489).
Meeker *vs.* Wilson, 1 Gall., 419; see p. 426.
Fuller *vs.* Harris, 29 Fed. Rep., 814.
Smith *vs.* Rentz, 73 Hun, 195; see p. 197.
Van Tassel *vs.* N. Y. & C. R. Co., 1 Misc., 312, 313.
Chandler *vs.* Thompson, 30 Fed. Rep., 38; see p. 44.
Mary *vs.* DeWolf, 3 Woodb, & B., 193.
Whetmore *vs.* Murdock, *Id.*, 380.
Washburn *vs.* Gould, 3 Story, 122–157.
Witter *vs.* Soules, 32 Fed. Rep., 765.

But if the new trial had been granted on all the issues, the grievance would not have been as serious, as it became in consequence of

the direction in the order, *not to permit the defendant to interpose any defense*, excepting as " to the numbers and times of the representations, if any there were, of the play of ' After Dark ' by the defendant within two years prior to the commencement of this suit " (93). Accordingly, when defendant demanded a jury trial, it was refused, because of the said limitation (93). On the first trial which resulted in the dismissal of the complaint, plaintiff's procedure did not require the defendant to put in all his evidence, and on the new trial, he was not allowed under the order granting it to put it in. He did not introduce his evidence at the first trial because he was satisfied that as the record stood, the complaint would have to be dismissed. If after that, plaintiff was given another chance in the game, the defendant, in fairness, should have been given an equal chance and should not have been excluded from introducing evidence *upon every issue* raised by the pleadings. The defendant was thus, in effect, deprived of his constitutional right to a trial. That was error and assigned as such (156).

Counsel argued below that as no additional evidence was offered by Brady at the new trial, on any of the issues relative to plaintiff's copyright, or the infringement by defendant, the objection cannot be raised. None could have been given or offered, because the *order limited* the proof to the number of performances that were given by Brady, and he consequently had no right to give or offer any evidence excepting on that question.

Had Brady asked for a new trial the Court might perhaps have had the right to impose the condition that the proof should be thus limited, but having been successful on the first trial, he cannot be deprived of the fruits of his victory by the granting of a new trial, and tying him up in that way on said new trial.

VIII.

The trial Judge erred in permitting the plaintiff upon the new trial to present the evidence of the number of performances as it was obtained from the information given by the defendant under compulsion in the equity suit.

In that suit, the defendant under compulsion of a subpœna disclosed the times and places where "After Dark" was performed (see Master's Report, 55; finding 18). The objection was taken that defendant could not be thus compelled to disclose facts which might tend to criminate and subject him to a penalty was overruled (19), as were also the exceptions to the report of the Master under Callahan *vs.* Meyers, 128 U. S., 618, where the Court held (see Syllabus):

> "Although the bill prays for a forfeiture to "the plaintiff, under the statute, of copies in "in possession of the defendant of the in- "fringing volume, and for their delivery to "the plaintiff, yet, if the final decree does not "award any forfeiture, the defendant is not "injured by anything done under such pro- "vision of the interlocutory decree; nor can "the penalties given by Section 7 of the Act "of 1831 be enforced in a suit in equity; *nor "can evidence obtained from the defendant "through his examination, and the produc- "tion by him of his books and papers, be used "against him in any other suit in which a for- "feiture is sought*" (italics ours).

The same rule is laid down in other cases.

Johnson *vs.* Donaldson, 3 Fed. Rep., 22.

Chapman *vs.* Ferris, 12 Fed. Rep., 693.

Atterill *vs.* Ferrett, 2 Blatch., 39.

Though the trial Judge, in dismissing the complaint in this action on the first trial, held that defendant's testimony in the equity suit could not be used against him, it was thus indirectly used on the new trial. Instead of reading said testimony, counsel sent commissions to the places where the defendant had disclosed he had given performances, and in that way got in the facts disclosed by that testimony. This was error, as it deprived the defendant of the protection guaranteed him by the constitution. When he was subpœnaed before the Master, he was obliged to disclose, under the said constitutional guaranty that his evidence should not be used against him, the times when and the places where the performances were given, but to permit plaintiff to secure proof from those places, and use it against him would be as effectually using his evidence as though it were read at the trial against him.

To prevent just such a wrong Section 860 of the Revised Statutes provides that "no pleading of a party nor any *discovery of evidence obtained from a party or witness by means of a judicial proceeding* in this or any foreign country, shall be *given in evidence or in any manner used against him or his property or estate in any Court of the United States, in any criminal proceeding or for the enforcement of any penalty or forfeiture*, provided that this section shall not exempt any party or witness from prosecution or punishment for perjury committed in discovering or testifying as aforesaid."

The security thus granted to a witness, is not merely that his evidence shall not be read on the trial of an action for the recovery of a penalty but that it *shall not be used in any manner against him in such a proceeding.* In defiance of that provision, plaintiff was allowed to use said evidence

as the basis for obtaining and introducing in evidence the information procured therein. The protection secured to defendant that his evidence should *in no manner* be used against him was circumvented and frittered away.

Counselman *vs.* Hitchcock, 142 U. S., 547.

People *ex rel.* Taylor *vs.* Forbes, 143 N. Y., 219.

IX.

The judgment should be reversed, with costs, and the proceedings remitted to the Court below with instructions to dismiss the complaint, with costs.

All of which is respectfully submitted.

A. J. DITTENHOEFER,
Of Counsel.